

REMARKS

In the Office Action, the Examiner restricted examination of claims 1-67 in the present application. Specifically, the Examiner restricted claims 1-25 to Group I as drawn to a method for analyzing a capital investment in medical resources for a medical facility, classified in *class 705, subclass 36*, restricted claims 26-47 to Group II as drawn to a system for analyzing a capital investment in medical resources for a medical facility, classified in *class 705, subclass 36*, restricted claims 48-59 to Group III as drawn to, classified in *class 705, subclass 36*, and restricted claims 60-67 to Group IV as drawn to, classified in *class 705, subclass 36*. In other words, the Examiner's four groups are all drawn to the same class and subclass, i.e., class 705, subclass 36.

After careful review of the Examiner's restriction requirement, the Applicant elects to prosecute claims 1-25 of Group I *with traverse*. The Applicant specifically objects to the foregoing restriction requirement based on the identical classifications, similarities between these claims, and the following sections of the Manual of Patent Examining Procedure.

First, the Applicant stresses that the Examiner failed to meet the requirements set forth by M.P.E.P. (Rev. 2, May 2004) § 806.05(d). For example, Section 806.05(d), which the Examiner cited as a basis for the restriction, specifically states:

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.

...

The burden is on the examiner to provide an example.

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

M.P.E.P. (Rev. 2, May 2004) § 806.05(d). In the Office Action, the Examiner merely recited the *preambles* (except for claim 1) from the different independent claims of different groups, and then stated without support that the claims have “different utility and scope.” Office Action mailed November 23, 2004, Page 2. However, the Examiner’s reasons for restriction are not supported by an example that one of the subcombinations has utility other than in the disclosed combination, as required by M.P.E.P. Section 806.05(d). Instead, the Examiner suggests without example that the “method of invention I can be performed by a system configuration different from what is claimed in invention II.” *Id.* Applicant stresses that this is not an example as required by M.P.E.P. Section 806.05(d). For this reason, the Examiner must “document a viable alternative use or withdraw the requirement,” as required by M.P.E.P. Section 806.05(d).

Second, the Applicant submits that the Examiner has failed to meet the requirements set forth by M.P.E.P. (Rev. 2, May 2004) § 808.02. Specifically, this section states:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) – § 806-05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) **Separate classification thereof...**

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places

where no *pertinent* art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be *pertinent* to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no *clear indication* of separate future classification and field of search, *no reasons exist for dividing among related inventions.*

M.P.E.P. (Rev. 2, May 2004) § 808.02. In the present Office Action, the Examiner clearly indicated that the different groups all pertain to class 705, subclass 36. Therefore, the Examiner cannot show *separate classification* under subheading (A) above. Regarding subheading (B), the Examiner has not provided an *explanation* indicating *recognition of separate inventive effort by inventors* sufficient to prove a *separate status* in the art. Finally, although the Examiner mentions separate searches, the Examiner failed to provide an explanation, much less an explanation meeting the requirements of subheading (C) above. See Office Action mailed November 23, 2004, Page 4. The Applicant stresses that any future explanation of different fields of search must be *pertinent* to the claims. After careful review of the different independent claims, the Applicant stresses that the present restriction requirement does not and cannot reasonably meet the requirements of M.P.E.P. Section 808.02.

Third, the Applicant object to the Examiner's rejection on the ground of a lack of "serious burden" on the Examiner. As set forth in the Manual of Patent Examining Procedure, the criteria for a restriction requirement include: (1) the inventions must be independent or distinct, and (2) there must be a serious burden on the Examiner. See M.P.E.P. (Rev. 2, May 2004) §§ 802.02 and 803. Specifically, the Applicant stresses that:

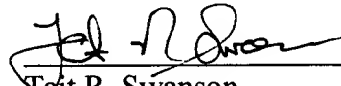
If the search and examination of an entire application can be made *without serious burden*, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

Id. at § 803. After careful review of the present application, the Applicant emphasizes that examination of all pending claims would not be a burden, much less a “serious burden,” on the Examiner. If the Examiner reviews the claim recitations in more detail, then the Applicant believes that the Examiner will agree that the pending claims can reasonably be examined without need for the foregoing restriction requirement. The Applicant also emphasizes that “[p]iecemeal examination should be avoided as much as possible.” M.P.E.P. (Rev. 2, May 2004) § 707.07(g), Page 700-122. For these reasons, the Applicant respectfully requests that the Examiner withdraw the restriction requirement and examine all pending claims.

If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Tait R. Swanson
Reg. No. 48,226
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545